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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,147	08/02/2007	Takefumi Yoshida	358362011200	5089

7590
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05/16/2008

EXAMINER

ARNBERG, MEGAN C

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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05/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,147	Applicant(s) YOSHIDA ET AL.	
	Examiner MEGAN ARNBERG	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/20/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 8, 11, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Maeda et al. (U.S. Pat. 5,866,668).

Regarding claim 1: Maeda et al. teaches a liquid multifunctional epoxy resin (col. 4 lines 8-34) and solid particles of diamines (col. 2 line 54-col. 3 line 5).

Regarding claim 3: Maeda et al. teaches the epoxy resin is liquid (col. 4 lines 8-34).

Regarding claims 4 and 8: Maeda et al. teaches a solvent such as toluene (col. 2 line 32), which has a boiling point of 110.06 °C.

Regarding claims 5, 11, 13 and 15: Maeda et al. teaches the solid particles have a size of less than 20 µm (col. 3 lines 1-5), which overlaps the claimed range.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 6, 7, 9, 10, 12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (U.S. Pat. 5,866,668) as applied to claim 1 above and in view of Karkozov et al. (SU 852914) The English language translation of this document is used for the citations below.

Regarding claim 2: Maeda et al. teaches the basic claimed composition as set forth above. Not disclosed is the compound having two or more amino groups in a molecule is an aromatic amine compound having a benzoxazole structure. However, Karkozov et al. teaches an epoxy composition comprising a benzoxazole structure (page. 3). Maeda et al. and Karkozov et al. are combinable because they are both concerned with the same field of endeavor, namely epoxy resin adhesives with solid diamine curing agents. At the time of the invention a person having ordinary skill in the

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art would have found it obvious to combine the benzoxazole compound of Karkozov et al. with the composition of Maeda et al. and would have been motivated to do so since Karkozov et al. states that the use of the benzoxazole as a curing agent raises the pot life and the heat resistance compared with compositions using 4,4-diaminodiphenyl methane and m-phenylene-diamine, which is used by Maeda et al. (pages 2 and 3).

Regarding claim 6: Maeda et al. teaches the epoxy resin is liquid (col. 4 lines 8-34).

Regarding claims 7, 9: Maeda et al. teaches a solvent such as toluene (col. 2 line 32), which has a boiling point of 110.06 °C.

Regarding claims 10, 12, 14, 16: Maeda et al. teaches the solid particles have a size of less than 20 μm (col. 3 lines 1-5), which overlaps the claimed range.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEGAN ARNBERG whose telephone number is (571)270-3292. The examiner can normally be reached on Monday - Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARK EASHOO/

Supervisory Patent Examiner, Art Unit 1796

12-May-08

/M. A./

Examiner, Art Unit 1796